

60. A method of diagnosing human cancer in a patient comprising:

(a) detecting amplification rearrangement or over-expression of the MAC117 gene by hybridizing nucleic acid derived from a tissue sample of said patient with a nucleic acid probe of the MAC117 gene; or

(b) detecting abnormal expression of the protein product of the MAC117 gene by reacting a body sample of said patient with antibodies having specific binding affinity for at least a portion of a MAC117 polypeptide.--

REMARKS

Reconsideration and Allowance of the above-referenced application are respectfully requested.

The Claims have been amended such that claims 14, 26, 29, 40, 41 and 44-60 remain for consideration.

New claims 44-47 and 60 are presented to further define the claimed invention. New claims 48 to 59 are presented pursuant to 37 C.F.R. § 1.607 for purposes of interference with U.S. Patent No. 4,968,603, which issued November 6, 1990 (The "Slamon patent"). A copy of the Slamon patent was provided with applicants' amendment of September 6, 1991. Newly presented claims 48 and 53 represent alternative versions of claim 1 of the

Slamon patent; newly presented claims 49-52 correspond to claims 2, 3, 4, and 6 of the Slamon patent, respectively; newly presented claims 54 and 59 represent alternative versions of claim 7 of the Slamon patent; newly presented claims 55-58 correspond to claims 9, 10, 11, and 15 of the Slamon patent, respectively; with changes intended to accommodate for disclosure differences. These differences are not, however, substantive or material and result in claims drawn to the same patentable invention as the Slamon patent claims.

Referring to the disclosure of the present application serial number 110,791 ('791) and the parent application 836,414 ('414), the newly presented claims find support as follows:

<u>Claim</u>	<u>Support</u>
44	Claim 8 as originally filed in '791 and '414. Figure 2 and pages 6-7, lines 16-14 of both '791 and '414. Pages 26-28, lines 23-5 and page 28, lines 9-19 of '791 which correspond to page 26-27, lines 5-25 of '414.
45	As indicated above with respect to claim 44, and further: Figure 1 of both '791 and '414
46	As indicated above with respect to claim 45.
47	As indicated above with respect to claim 44, particularly page 27, line 10 of '791 which corresponds to page 26, line 16 of '414.
48	As indicated above with respect to claim 44.

- 49 As indicated above with respect to claim 48,
particularly page 26 lines 23-25 of '791 which
corresponds to page 26, lines 5-7 of '414.
- 50 As indicated above with respect to claim 48,
particularly page 27 lines 25-27 of '791 which
corresponds to page 27, lines 8-10 of '414.
- 51 As indicated above with respect to claim 48,
particularly page 27 line 21 of '791 which corresponds
to page 27, line 4 of '414.
- 52 As indicated above with respect to claim 48.
- 53 As indicated above with respect to claim 48,
particularly page 27, line 10 of '791 which corresponds
to page 26, line 16 of '414.
- 54 As indicated above with respect to claim 44.
- 55 As indicated above with respect to claim 54,
particularly Figure 2 and pages 6-7, lines 16-14 of
both '791 and '414.
- 56 As indicated above with respect to claim 54,
particularly page 27 lines 25-27 of '791 which
correspond to page 27, lines 8-10 of '414 and page 27
line 21 of '791 which correspond to page 27, line 4 of
'414.
- 57 As indicated above with respect to claim 54,
particularly pages 27-28 lines 22-5 and page 28 lines
9-19 of '791 which correspond to page 27, lines 5-25 of
'414.
- 58 As indicated above with respect to claim 54.
- 59 As indicated above with respect to claim 54,
particularly page 27, line 10 of '791 which corresponds
to page 26, line 16 of '414.
- 60 As indicated above with respect to claim 54,
particularly claim 8 as originally filed in both '791
and '414.

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While applicants herein have been claiming the same invention as that set forth in the Slamon patent since the filing of their parent application, nevertheless, presently presented claims 44-60 have been added to more fully underscore common subject matter that both parties are claiming.

Further, in compliance with 37 CFR §1.607(a)(2), the following count is proposed:

Count A --A method for the diagnosis or prognosis of human cancer in a patient, said method comprising:

measuring the level of amplification or expression of the HER-2/neu or MAC117 gene in a sample from a patient and

classifying those patients having an increased level of amplification or expression of said gene as being likely to suffer from cancer, to suffer disease relapse or having a decreased chance of survival.--

With respect to proposed Count A it will be appreciated that the count is a phantom count taking into account the broadest aspects of the Slamon patent claims 1 and 7 and applicants claim 44 (and original claim 8). It should be noted that the HER-2/neu gene is the same as applicants MAC117 gene (see Slamon patent column 2, lines 39-43 and applicants

disclosure at page 21, lines 14-23 and parent application SN 836,414 at page 21, lines 14-23).

Each of applicants' claims now pending, as well as Slamon patent claims 1-22 should be designated as corresponding to the proposed Count A.

As noted above, proposed Count A embodies the broadest scope of Slamon patent claims 1 and 7, together with applicants' claim 44 and original claim 8. The remaining claims of both parties do not patentably distinguish from the proposed count.

In view of the above comments, it is respectfully submitted that an interference should be declared.

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In view of the foregoing, it is respectfully submitted that all applicants' claims are in acceptable form and define a patentable invention over the art of record. Accordingly, favorable consideration and Allowance are respectfully requested.

Respectfully submitted,

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